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10/046,933	10/26/2001	Timothy R. Bratton	REAL-2007115(RN113)	8588
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AXIOS LAW GROUP, PLLC / REALNETWORKS, INC 1525 4TH AVE, STE 800 SEATTLE, WA 98101-1648			EXAMINER SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/046,933	<b>Applicant(s)</b> BRATTON ET AL.	
	<b>Examiner</b> CRISTINA SHERR	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-36 and 38-60 is/are pending in the application.
- 4a) Of the above claim(s) 9-14, 32-36, 38, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15-31, 39-50, and 53-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Amendment filed February 11, 2009. Claims 1-12, 14-36 and 38-60 are currently pending in this case. Claims 13 and 37 were previously canceled. Claims 1-8, 15-31, 39-50, and 53-60 are currently under examination. Claims 1, 4, 6, 7, 8, 15, 16, 18, 19, 20, 21, 22, 23, 25, 26, 27, 30, 31, 39, 42, 43, 44, 45, 46, 47, 48, 49, 50, 54, 56, 58, 59, and 60 are currently amended.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 31, 2008 has been entered.

#### ***Election/Restrictions***

3. Claims 9-14, 32-36, 38, and 51-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 11, 2009.

#### ***Response to Arguments***

4. Applicant's arguments filed October 6, 2009 have been fully considered but they are not persuasive. Applicant argues regarding claim 1, as currently amended, that nothing in the cited prior art teaches, discloses, or suggests, "that the first data file

Art Unit: 3685

comprises the media file lacking at least one portion from each of a plurality of locations within the media file.”

5. Examiner respectfully disagrees and directs attention to Mages, wherein, at col 6 In 39-43, content may be crippled by removing critical information *such as* the video-audio header. (emphasis added). Note that the term “such as” indicates that the header is merely one example of critical information to remove. Further, Mages recites that “it is possible to ‘cripple’ . . . by means other than deleting the header thereof.” (col 8 In 21-23). Thus, it would be obvious to one of ordinary skill in the art that other critical information could and would do the trick. Such a variation would merely be a predictable result. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

6. Applicant argues, regarding claim 1, as currently amended, that nothing in the cited references teaches, discloses or suggests “a second data file that comprises the at least one portion lacking from each of said plurality of locations within the media file.”

7. Examiner respectfully disagrees and directs attention to Hazra, wherein the multiple layers of a single data stream (e.g. col 8 In 54-58) are the equivalent of the multiple portions in the instant application, and each may be received and decoded without reference to the others (e.g. col 9 In 1-15). Also, in Mages, note that col 8 In 50-col 9 In 15 where the “header-trigger or other file” is stored at a server, and sent to the end-user computer so that the audio or video file may be played back.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-8, 15-31 and 39-50 are rejected under 35 U.S.C. 101.

10. In this case, claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

11. In this case, specifically, claim 1 recites receiving first and second data files without clearly specifying who or what receives. Further, claim 1 also recites creating a file which somehow combines these first and second data elements also without specifying who or what creates and combines. Thus, independent claim 1 and its dependent claims 2-8 are rejected under 35 U.S.C. §101.

12. Under the broadest reasonable interpretation standard, claims 15-25 recite a computer program only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of

Art Unit: 3685

invention.<sup>1</sup> Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

13. In this particular case, independent claim 15 recites a “media client”, which is interpreted as software or computer program. Thus, independent claim 15 and its dependent claims 16-25 are rejected under 35 U.S.C. 101.

14. In this particular case, independent claim 26 recites reception means, and media assembly means in a device. Using the broadest reasonable interpretation of “means”, the claimed means are interpreted as software only, And thus independent claims 26 and its dependent claims 27-31 are rejected under 35 U.S.C. 101.

15. In this particular case, independent claim 39 recites file managers and a “media file reconstructor”, which are interpreted as software or computer program. Thus, independent claim 39 and its dependent claims 40-50 are rejected under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (*i.e.*, inventions that consist of a series of steps or acts to be performed).

Art Unit: 3685

18. Claims 1 discloses "receiving a second data file with the electronic data device from a second computing device". It is unclear what is being received. Is it only the data file or is the data file being received along with physically the electronic data device? Further, it is unclear who or what is receiving the file. For these reasons, claim 1 and its dependent claims 2-8 are rejected under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-8, 15-31, 39-50, and 53-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al (6,185,306) in view of Hazra (US 6,510,553).

21. Mages discloses a method of assembling a media file for playing in an electronic device, comprising:

receiving a first data file with the electronic device from a first computing device via a first communication channel as a result of commands initiated from a media client of the electronic device, wherein the first data file comprises the media file lacking at least one portion from each of a plurality of locations within the media file and is unusable as a media file; (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8, col 8 ln 21-23).

receiving a second data file with the electronic device from a second computing device via a second communication channel as a result of commands initiated from the media client, wherein the second data file comprises said at least one portion lacking from each of said plurality of locations within the media file and is unusable as a media file ; and (col 8 ln 50- col 9 ln 15 where the "header-trigger or other file" is stored at a server, and sent to the end-user computer so that the audio or video file may be played back.)

creating with the media client the media file in the electronic device from the first data file and the second data file. (col 8 ln 50- col 9 ln 15 where the "header-trigger or other file" is stored at a server, and sent to the end-user computer so that the audio or video file may be played back.)

22. Mages does not specifically disclose removing at least one portion from each of a plurality of locations within the media file. However, as above, Mages discloses, at col 6 ln 39-43, content may be crippled by removing critical information *such as* the video-audio header. (emphasis added). Note that the term "such as" indicates that the header is merely one example of critical information to remove. Further, Mages recites that "it is possible to 'cripple' . . . by means other than deleting the header thereof." (col 8 ln 21-23). Thus, it would be a predictable result that other critical information could and would do the trick. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).



Art Unit: 3685

23. Additionally, Hazra discloses, which Mages does not, having a plurality of second file portions (e.g. col 4 ln 18-40), wherein each may be received without reference to the content of the others (e.g. col 8 ln 54 – col 9 ln 15).

24. It would be obvious to one of ordinary skill in the art to combine the teachings of Mages and Hazra motivated by the desire for a faster transmission, thus avoiding “choppy” playing of media.

25. Regarding the wireless limitations of claims 2, 16, 21, 22, 27, 42, 50, and 54 Mages teaches receiving a second data file with an electronic device. (col 8 ln 50- col 9 ln 15). Further, with respect to the wireless device that it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. *In re Lindberg*, 93 USPQ 23 (CCPA 1952). Further, Official Notice is taken that it is old and well-known to disconnect once transmission is complete, since there would no further need for the connection at that point and in order to prevent further charges.

26. Regarding limitations of claims 3, 4, 17, 23, 25, 28, 29, 40, 41, 20, 48, 49, 56 and 55 -

27. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 3050, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

28. Regarding the component limitations of claim 5, 24 and 57

Art Unit: 3685

29. The references do not specifically disclose the use of synch cradles or docking stations. Official notice is taken that such devices are old and well known. Further, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *In re Dulberg*, 129 USPQ 348, (CCPA 1961).

30. Regarding transmission limitations of claim 6, 46, 47, and 58 --

31. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

32. Regarding limitations of claims 7, 18, 30, 31, 43, and 59

33. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

34. Regarding key limitations of claims 8, 19, 44, and 60

35. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations because uncripping is based on employing a key.

### ***Conclusion***

Art Unit: 3685

36. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

37. Milestones in AT&T History, at <http://www.corp.att.com/history/milestones.html>.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

39. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

40. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR  
Examiner  
Art Unit 3685

Application/Control Number: 10/046,933

Page 11

Art Unit: 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685